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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/091,173

03/06/2002

John Voneiff

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07/24/2006

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER

PRONE, JASON D

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/091,173

Applicant(s)

VONEIFF ET AL.

Examiner

Jason Prone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-35 is/are pending in the application.
4a) Of the above claim(s) 12,13,17,18,20-26,32 and 34 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 11,14-16,19,27-31,33 and 35 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 06 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. In light of applicants comments pointing out the section of the specification that states "In one embodiment, the optical imaging system locates the position and orientation of the tissue sample...". Page 17 lines 28-29 states that the optical imaging system, of the elected species, only determines location. Therefore, the "one embodiment" referred to above is not the species that was elected and therefore, claims 17 and 18 have been withdrawn.

Specification

2. The disclosure is objected to because of the following informalities: On the last 2 lines of amended paragraph [0055], the phrase "which may be located on slide conveyer 250" should be replaced with "which may be located on slide conveyer 230". It is assumed that this is a typo and a further drawing objection is not necessary.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 11, 14, 27, 29, 31, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by McCormick (5,156,019).

Claims 11 and 14:

In regards to claim 11, McCormick discloses the same invention including a blade assembly for slicing thin section from a work piece (18), a plurality of transfer rollers sequentially arranged in tangential proximity to each other (40a, 48, and 40), a thin section on the surface of one transfer roller will be transferred to the surface of the sequentially successive transfer roller (40 Fig. 1, it is noted that item A need not be directly in contact with item B to be considered on the surface of item B. For example, if three books were stacked, the highest book is still on the surface of the lowest book via the middle book), a first sequential transfer roller is oriented in proximity to the blade assembly (40a) so that a thin section sliced from the work piece will contact the surface of the first sequential transfer roller (26 contacts belt 24 which contacts roller 40a, therefore 26 contacts the surface of 40a), and a receiving medium (62) disposed in tangential proximity to a final sequential transfer roller (far right 40) so that the thin section on the surface of the final sequential roller will be transferred to the receiving medium in a substantially smooth and flat configuration (occurrence of 26 to the right of 40).

In regards to claim 14, McCormick discloses at least a portion of a circumference of one of the transfer roller is temperature controlled (40a, roller 40a is within an environment defined by 22 which is kept at a specific temperature, since the roller would take on the specific cold property, it therefore, is temperature controlled).

Claims 27, 29, 31, and 33:

In regards to claim 27, McCormick discloses the same invention including a holding assembly for manipulating a work piece (16), a blade assembly for preparing a

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thin section from the work piece (18), a transfer roller mechanism (40a, 48, and 40) for transferring the thin section to a receiving medium (62), and a controller (34).

In regards to claim 29, McCormick discloses the controller tracks the work piece (34, meaning the controller runs the work piece along a specific oscillatory path).

In regards to claim 31, McCormick discloses a first transfer roller positioned adjacent to the blade assembly for receiving the thin section from the blade (40a) and a second transfer roller for receiving the thin section from the first transfer roller and transferring the thin section to the receiving medium (40).

In regards to claim 33, McCormick discloses at least a portion of a circumference of one of the transfer roller is temperature controlled (40a, roller 40a is within an environment defined by 22 which is kept at a specific temperature, since the roller would take on the specific cold property, it therefore, is temperature controlled).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick in view of Burkhardt (3,286,575). McCormick discloses the invention including a blade assembly for producing thin sections (18).

However, McCormick fails to disclose a first blade assembly. Burkhardt teaches a first or preliminary blade assembly (Column 1, lines 33-35). It is also old and well

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known in the art of manufacturing to cut a work piece down to a specific size so that the work piece fits in the next machine of the manufacturing process. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided McCormick, with a first or preliminary blade assembly, as taught by Burkhardt, to cut away unwanted parts of the work piece before the critical cutting takes place.

7. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick in view of Hayashi et al. (6,006,737). McCormick discloses the invention but fails to disclose a blade supply canister and the blade is advanced from the blade supply canister at predetermined intervals. Hayashi et al. teaches that it is old and well known in the art of stationary blade/moving workpiece saw to incorporate a blade supply canister (2) and the blade is capable of being advanced from the blade supply canister at predetermined intervals (3). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided McCormick, with the slicing means, as taught by Hayashi et al., to provide a longer lasting blade to perform the slicing function.

8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick in view of Blumenfeld (6,074,868). McCormick discloses the invention but fails to disclose a display means for displaying operating information. Blumenfeld teaches that it is old and well known in the art of machines adapted to work with slides to incorporate a display means (22b). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided McCormick, with a

display means, as taught by Blumenfeld, to allow the productivity of the machine to be watched and corrected if need be.

9. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick in view of Burkhardt (3,286,575). McCormick discloses the invention but fails to disclose a preliminary blade assembly capable of removing slices from the work piece. Burkhardt teaches a preliminary blade assembly capable of removing slices from the work piece (Column 1, lines 33-35). It is also old and well known in the art of manufacturing to cut a work piece down to a specific size so that the work piece fits in the next machine of the manufacturing process. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided McCormick, with a first or preliminary blade assembly, as taught by Burkhardt, to cut away unwanted parts of the work piece before the critical cutting takes place.

10. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick in view of Dunlay et al. (5,989,835). McCormick discloses the invention including the controller determines an orientation of the sample blade with respect to the blade assembly (34).

However, McCormick fails to disclose an optical imaging system for locating the tissue sample within the sample block. Dunlay et al. teaches an optical imaging system for locating the tissue sample within the sample block (Abstract). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided McCormick, with an optical imaging system, as taught by Dunlay et al., to allow the user to detect best part of the work piece to work with.

11. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick in view of Hayashi et al. McCormick discloses the invention but fails to disclose a blade supply canister the blade is advanced from the blade supply canister at predetermined intervals. Hayashi et al. teaches that it is old and well known in the art of stationary blade/moving work piece saw to incorporate a blade supply canister (2) and the blade is capable of being advanced from the blade supply canister at predetermined intervals (3). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided McCormick, with the slicing means, as taught by Hayashi et al., to provide a longer lasting blade to perform the slicing function.

Response to Arguments

12. Applicant's arguments filed 10 May 2006 have been fully considered but they are not persuasive. With regards to arguments pertaining to the McCormick reference and claim 11, proximity is defined as: The state, quality, sense, or fact of being near or next. Rollers 40a, 48, and 40 are clearly tangentially positioned relative to one another and are clearly near one another. The term "on" is defined as: used to indicate position above and supported by or in contact with. The tissue is clearly above and supported by the surface of the transfer roller. In regards to claim 27 arguments, all that is claimed is a transfer roller for transferring a work piece to a receiving medium. In McCormick, items 40a, 48, and 40 clearly transfer tissue 26 to a receiving medium 62 via the conveyer. Definition source: The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2000 by Houghton Mifflin Company. Published by Houghton Mifflin Company. All rights reserved.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:00-4:30, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

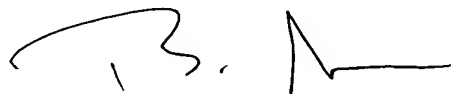
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JP
July 17, 2006



BOYER D. ASHLEY
SUPERVISORY PATENT EXAMINER